

**REMARKS**

Favorable reconsideration of this application is requested in view of the above amendments and the following remarks. Claims 32 and 42 are amended. Claims 1-4, 6-26, 28-32, and 34-55 remain actively pending in the case. No new matter has been added. Reconsideration of the claim is respectfully requested.

On page 4 of the Office Action, claims 1-4, 6-12, 15-26, 29-32, 34-51 and 55 were rejected under 35 USC 103(a) as being unpatentable over United States Postal Service (USPS) in view of an article by Glen Stephens (Stephens) teaching personalized postage stamps at Australia 99 World Stamps Expo, and further in view of an article by Marilyn J. Brackney (Brackney), Microsoft Paint and Brasington et al. (U.S. 5,923,406). On page 16, dependent claims 13-14 were rejected under 35 USC §103(a) as being unpatentable over United States Postal Service in view of an article by Glen Stephens teaching personalized postage stamps at Australia 99 World Stamps Expo, and further in view of an article by Marilyn J. Brackney, Microsoft Paint, Brasington et al. and Kara (U.S. 5,819,240). Claim 28 was rejected under 35 USC §103(a) as being unpatentable over United States Postal Service in view of an article by Glen Stephens teaching personalized postage stamps at Australia 99 World Stamps Expo, and further in view of an article by Marilyn J. Brackney, Microsoft Paint and Brasington et al. On page 17, claims 52-54 were rejected under 35 USC §103(a) as being unpatentable over United States Postal Service in view of an article by Glen Stephens teaching personalized postage stamps at Australia 99 World Stamps Expo, and further in view of an article by Marilyn J. Brackney, Microsoft Paint and Brasington et al. and Mold (U.S. 5,978,772). Applicants respectfully traverse the rejections.

USPS fails to teach or suggest at least a central authorizing computer system having a computer program for forwarding information to said at least one remote ordering system for display on said display device and allowing customizing of an official postal stamp by a user from said at least one remote ordering system as recited in claim 1. Rather, USPS merely discloses that stamps and stamp collectibles can be bought online. *See* pages 4-5 of 15. USPS does not disclose, explicitly or inherently, a central authorizing computer system having a computer program for allowing customizing of an official postal stamp

by a user from said at least one remote ordering system. Also, there is no teaching in Stephens that the online site is capable of receiving information to allow customizing. Furthermore, USPS does not disclose a central authorizing computer system, as disclosed by Applicant, for forwarding information to said at least one remote ordering system for allowing customizing of official postal stamps. See page 15 of Applicants' Specification.

In order to render a claim anticipated by the prior art, each and every element of the claim must be disclosed in a single reference. In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005). In fact, the Federal Circuit explained that the specification is "usually . . . dispositive. . . [and] the single best guide to the meaning of a disputed term." *Id.* (quoting *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1582). For these reasons, the Federal Circuit confirmed that it is "entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Phillips*, 415 F.3d at 1317.

Hence, allowing customizing of an official postal stamp by a user from at least one remote ordering system is not even inherently present in USPS.

Stephens fails to remedy the deficiencies of USPS as Stephens fails to teach or suggest at least a central authorizing computer system having a computer program for forwarding information to said at least one remote ordering system for display on said display device and allowing customizing of an official postal stamp by a user from said at least one remote ordering system as recited in claim 1. Rather, Stephens discloses that digital images of collectors, captured by a digital camera, are printed on pre-printed and perforated gummed stamps. See page 2 of 4. Stephens system does not disclose, explicitly or inherently, a central authorizing computer system for forwarding information to at least one remote ordering system for allowing customizing of official postage stamps. A central authorizing computer system that capable of forwarding information and a digital camera capable of receiving information, to allow customizing of an official postage stamp by a user from at least one remote ordering system, is not event inherently present in Stephens.

Brachney fails to remedy the deficiencies of USPS and Stephens as Brachney fails to teach or suggest at least a central authorizing computer

system having a computer program for forwarding information to said at least one remote ordering system for display on said display device and allowing customizing of an official postal stamp by a user from said at least one remote ordering system as recited in claim 1. At best, Brachney discloses emailing electronic images of art and lettering for postage stamps. A central authorizing computer system that capable of forwarding information to allow customizing of an official postage stamp by a user from at least one remote ordering system, is not event inherently present in Brachney.

Microsoft Paint fails to remedy the deficiencies of USPS, Stephens and Brachney as Microsoft Paint fails to teach or suggest at least a central authorizing computer system having a computer program for forwarding information to said at least one remote ordering system for display on said display device and allowing customizing of an official postal stamp by a user from said at least one remote ordering system as recited in claim 1. A central authorizing computer system that capable of forwarding information to allow customizing of an official postage stamp by a user from at least one remote ordering system is not event inherently present in Microsoft Paint.

Brasington fails to remedy the deficiencies of USPS, Stephens, Brachney and Microsoft Paint as Brasington fails to teach or suggest at least a central authorizing computer system having a computer program for forwarding information to said at least one remote ordering system for display on said display device and allowing customizing of an official postal stamp by a user from said at least one remote ordering system as recited in claim 1. Rather, Brasington discloses vending machines for printing personalized postage stamps. In Brasington, a microcontroller 31 in a vending machine 1 displays a menu to a user for selecting personal postage stamp options or payment methods. Col. 3, lines 43-48. A telephone line connected to the vending machine 1 allows communication to a credit card data center 47 for an alternate means of payment. Col. 3, lines 24-27, 50-62. Further, Brasington discloses that revenue taken in by a vending machine 1 is deducted from a prepaid account (of an owner of the vending machine) at a data center 49 and sent in a single direction to a postal authority 91. Col. 6, lines 1-10; Fig. 4. Accordingly, neither the data center 49 nor the postal authority 91 forwards information to at least one remote ordering system for display on a display device and allowing customizing of an official

postal stamp by a user from said at least one remote ordering system.

Furthermore, a central authorizing computer system that capable of forwarding information to allow customizing of an official postage stamp by a user from at least one remote ordering system is not event inherently present Brasington. That is, the microprocessor 31, local in the vending machine 1, controls memory 35 and display 15. Col. 4, lines 15-17.

Thus, it is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of the sixth and seventh applied prior art references to Kara and Mold is moot, inasmuch as the combination of USPS, Stephens, Brachney, Microsoft Paint, Brasingon, Kara and Mold still lack any teaching, disclosure, or suggestion concerning a central authorizing computer system having programming for forwarding information to allow customizing of an official postage stamp by a user from at least one remote ordering system as previously discussed.

Also, Applicants respectfully contend that a *prima facie* case of obviousness has not been established, as described more fully below. To establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.  
(M.P.E.P. §2142).

Applicants respectfully submit that the cited references do not teach or suggest all the claim limitations as discussed above.

Further, there must be some actual *motivation* to combine the references found in the references themselves, the knowledge of one of ordinary skill in the art or from the nature of the problem to be solved that would suggest the combination. Without a suggestion of the desirability of "the combination," a combination of such references is made in hindsight, and the "range of sources available, however, does not diminish the requirement for actual evidence." *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). The Examiner must show some objective teaching leading to the combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). It is respectfully submitted that there is no

such objective teaching in at least Microsoft Paint that leads "to the combination" of Microsoft Paint with Brackney, and the Examiner has pieced together aspects purportedly found in the prior art to arrive at the invention through hindsight. As stated by the Federal Circuit:

**"Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight."**

*In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); emphasis added).

Therefore, in view of the above remarks, Applicants' independent claim 1 is patentable over the cited references. Rejected independent claims 32, 42, 49, 50, 52, 54 and 55 recite one or more feature generally similar to those of claim 1 discussed above. Accordingly, for similar reasons as discussed above, independent claims 32, 42, 49, 50, 52, 54 and 55 and 37 are believed to be patentable over the cited references. Because claims 2-4, 6-26 and 28-31 depend from claim 1, 34-41, 43-48, 51, 53 depend from claims 32, 42, 50 and 52, respectively, and include the features recited in the independent claim, Applicants respectfully submit that claims 2-4, 6-26, 28-31, 34-41, 43-48, 51 and 53 are also patentably distinct over the cited references. Nevertheless, Applicants are not conceding the correctness of the Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.